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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/737,341

12/15/2000

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956.1057

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06/30/2008

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EXAMINER

NGUYEN, CAM LINH T

ART UNIT

PAPER NUMBER

2161

MAIL DATE

DELIVERY MODE

06/30/2008

PAPER

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAMES C. COLSON and BRIAN LEE WHITE EAGLE

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Appeal 2008-0374  
Application 09/737,341<sup>1</sup>  
Technology Center 2100

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Decided: June 30, 2008

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*Before:* JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and  
JAY P. LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 43 to 59 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> Application filed December 15, 2000. The real party in interest is International Business Machines Corporation (IBM).

Appellants' invention relates to system, method and computer program (hereinafter, method) for synchronizing data. More specifically, when a mobile device (for example) with a limited address memory is synchronized with a larger computer, there is not room in the mobile device to store all of the addresses, phone numbers or other data elements that are in the larger computer. The user, with this invention, can specify the priority of his or her contacts, so, for example, those people whom the user contacts most often will have their data synchronized with higher priority. The prioritization scheme also goes so far as to order the data within a single contact, so, for example, the work number will have a higher priority than the home number. In the words of the Appellants:

The present invention provides a method for prioritizing data for use in synchronizing data at a client device 42, 44, 45, or 46. One method according to the invention includes receiving a synchronization session request 80, selecting a prioritization scheme 20 associated with a user 72, 84, and retrieving scheme effecting data 85 based on the prioritization scheme 20. (p. 20, line 19 – p. 21, line 4; p. 23, lines 2-5; p. 23, lines 8-14). In addition, this method includes producing a prioritized data set 96 based on the prioritization scheme 20 and the scheme effecting data. (p. 25, lines 6-10). The prioritized data set has a number of entries with each respective entry ordered with respect to each other entry according to the prioritization scheme 20 and with data for each entry also ordered according to the prioritization scheme 20. (p. 28, line 10 – p. 29, line 2; p. 30, line 20 – p. 31, line 5).

(App. Br. 2, 1<sup>st</sup> para.).

Claim 43 is exemplary:

43. A method for prioritizing data for use in synchronizing data at a client device, the method including:

- (a) receiving a synchronization session request;
- (b) selecting a prioritization scheme associated with a user;
- (c) retrieving scheme effecting data based on the prioritization scheme; and
- (d) producing a prioritized data set based on the prioritization scheme and the scheme effecting data, the prioritized data set having a number of entries therein with each respective entry ordered with respect to each other entry according to the prioritization scheme and with data for each entry also ordered according to the prioritization scheme.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Boothby	US 6,212,529 B1	Apr. 3, 2001
Bodnar	US 6,295,541 B1	Sep. 25, 2001

Rejections<sup>2</sup>:

R1: Claims 43, 44, 49, 50, and 55 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Boothby.

R2: Claims 45 to 48, 51 to 54, and 56 to 59 stand rejected under 35 U.S.C. § 103(a) for being obvious over Boothby in view of Bodnar.

Appellants contend that the claimed subject matter is not anticipated by Boothby, or rendered obvious by Boothby alone, or in combination with Bodnar, for failure of the references to teach a key limitation of the claims. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details.

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<sup>2</sup> The Examiner has indicated that a rejection under 35 U.S.C. § 101 and a rejection under 35 U.S.C. 112(2) have been withdrawn. (Answer 5, bottom).

Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

*See* 37 C.F.R. § 41.37(c)(1)(vii).<sup>3</sup>

We affirm the rejections.

### ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 102(e) and 103(a). The issue turns on whether Boothby teaches the reordering of the entries of the prioritized data set, and the data for each entry, as claimed.

### FINDINGS OF FACT

1. Appellants' invention relates to a method to prioritize data in anticipation of synchronizing that information between a client device and another computer. (Spec. 2:18). As the client device may not have sufficient storage for the whole database to be synchronized, the invention establishes a prioritization scheme to prioritize the data so the most important information is synchronized (sync'd) first. (Spec. 4, top). The prioritization considers not only the data itself, for example, the phone number, but the metadata attached to it, for example, the information that

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<sup>3</sup> Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

phone number is a home phone number. The combination of data and metadata is called the “scheme effecting data” in this application. (Spec. 4:11 to 14). The prioritization affects the order not only of the data entries, for example, the people that the user contacts most often, but also the data elements for each entry, for example the office number over the home number. (Spec. 27:17 to 19).

2. The reference Boothby likewise is concerned with synchronizing the data from multiple databases, such as a local computer and a handheld device. (Col. 4, l. 64). The filtering scheme, embodied in a robust set of filtering expressions (Col. 12, ll. 5 to 30), permits the synchronization program to selectively share the data from two or more data sources. (Col. 3, top).

#### PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.”

"[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

#### ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejections of Appellants' claims under 35 U.S.C. §§ 102 and 103. The prima facie case is presented on pages 3 to 5 of the Examiner's Answer.

In opposition, Appellants present two main arguments, applicable to both rejections. The first argument contends that Boothby does not teach changing the order of the entries with respect to each other, and the second argument contends that even if Boothby does teach changing the order of the entries, it does not teach changing the order of the data within an entry. (App. Br. 10:2 to 4).

Concerning the first argument, the Appellants express their contention as follows:

The Boothby patent does not teach or suggest the prioritization of data as required by element (d) of claim 43. In contrast, Boothby discloses applying a filter which results in some records in a source data set being flagged as passing the filter and the remainder of the records being flagged as not passing the filter.

(App. Br. 9:24 to 27).

The Examiner points to column 6, lines 20 to 24, where Boothby describes his intelligent filter, which has the capability of filtering based on the content of a data field, such as the priority field for a “to do” item. (Answer 6, middle). In the cited example, only records with priority values of 1, 2, or 3 will be synchronized, in accordance with a rule. The Examiner reasons that in deleting from the synchronization those records with priorities not in the accepted range, the entries are re-ordered with respect to each other, as the original order of the records is changed after the synchronization. Reading the claims in a broad but fair manner, we find that the Examiner has not made an error with respect to that logic, as indeed the order of the entries is changed when some of them are missing.

Appellants further contend that Boothby does not anticipate (nor contribute to rendering obvious) the limitations in claim 43 and the other independent claims because:

Even assuming for the sake of argument that the flagging of records according to Boothby produces a prioritized data set, there is no suggestion in Boothby that the filter operation orders records as required by element (d) of claim 43. Furthermore, there is no suggestion in Boothby that the filter operation orders data within each record as required by element (d) of claim 43.

(App. Br. 10:4 to 8).

We accepted above the Examiner’s argument concerning the teaching in Boothby of his synchronization potentially resulting in a change in the order of records. But does Boothby teach changing the order of data within each record? We find that Boothby does.



In Boothby, the synchronization program uses a field map “to determine which field of the local database corresponds to a field of the remote database used in the filter expression. Field mapping is described in U.S. Pat. No. 5,392,390, incorporated by reference.” (Col. 13, l. 66 – col. 14, l. 2). That quoted U.S. patent, to Keith Crozier, explains how data mapping can result in the re-ordering of the fields of a single record, as best illustrated in Figure 11 of that patent. (See Col. 12, ll.16 to 31). We thus see in the Boothby reference a teaching of using field mapping in the synchronization program, and in the incorporated Crozier patent a teaching that field mapping would result in “data for each entry also ordered according to the prioritization scheme” as claimed.

Appellants have based their appeal for both rejections upon these two arguments presented above. (App. Br. 12, middle; 13, middle). We do not find error in either rejection.

#### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 43, 44, 49, 50, and 55 under 35 U.S.C. § 102(e) for being anticipated by Boothby; nor in rejecting claims 45 to 48, 51 to 54, and 56 to 59 under 35 U.S.C. § 103(a) for being obvious over Boothby in view of Bodnar.

#### DECISION

The Examiner's rejections of claims 43 to 59 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2008-0374  
Application 09/737,341

AFFIRMED

tdl/ce

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